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In re Application of	:	
Uwe Witt et al.	:	
Serial No. 08/793966	:	DECISION
PCT No.: PCT/EP95/02722	:	
Int. Filing Date: 12 July 1995	:	ON
Priority Date: 09 September 1994	:	
Attorney's Docket No.: BOET 0103 PUSA	:	PETITION
For: Biologically Degradable Polyester and Working	:	
Material Consisting Thereof	:	

This is in response to the "Combined Petition for Revival of an Application for Patent Abandoned Unavoidably Under 37 C.F.R. 1.137(a) and Showing Related Thereto Under 37 C.F.R. 1.137(a)(3)" of 05 April 1999.

BACKGROUND

On 27 June 1996, applicant filed international application No. PCT/EP95/02722 which claimed an earliest priority date of 09 September 1994 and which designated the United States.

On 04 April 1996, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire 30 months from the priority date, on 10 March 1997 (since 09 March 1997 was a Sunday).

On 10 March 1997, applicant filed a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, *inter alia*, the basic national fee.

On 16 April 1997, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) were mailed to applicant, requiring the submission of an oath or declaration in compliance with 37 CFR

1.497(a) and (b) and a surcharge under 37 CFR 1.492(e) by 19 May 1997 (since 17 May 1997 was a Saturday). The declaration was deemed defective in that it did not identify the citizenship of each inventor, and did not identify the city and state or city and foreign country of residence of each inventor.

On 15 May 1997, applicant submitted a "Declaration for Utility or Design Patent Application" which identified the name, city and country of residence, citizenship, and post office address of each of the inventors, but which was not signed by inventor Uwe Witt.

On 25 June 1997, a Notification of a Defective Response (Form PCT/DO/EO/916) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) were mailed to applicant, indicating that all of the requirements set forth in the PCT/DO/EO/905 mailed on 16 April 1997 had not been met in that the declaration of 15 May 1997 had not been executed by all of the inventors in accordance with 37 CFR 1.66 or 1.68. The PCT/DO/EO/916 set a one month time limit to complete the response to the PCT/DO/EO/905 mailed on 16 April 1997.

On 08 July 1997, applicant submitted an "Applicants' Response to 'Notification of a Defective Response'", which indicated that the declarations of 15 May 1997 and 10 March 1997, taken together, fully satisfied the requirements of 37 CFR 1.497 and 1.63 and requested acknowledgment of such satisfaction.

On 02 January 1998, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that this application had been abandoned as to the United States because "Applicant has failed to properly respond to the defective response notice. 1st Declaration citizenship was omitted 2nd Declaration one applicant did not sign."

On 17 September 1998, applicant submitted a Status Letter.

On 17 November 1998, a communication was mailed to applicant in response to the status letter of 17 September 1998, indicating that the application had become abandoned as reflected by the Form PCT/DO/EO/909 mailed on 02 January 1998. A copy of said Form PCT/DO/EO/909 accompanied the communication.

On 05 April 1999, applicant submitted the instant petition.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due

date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

Petitioner has failed to provide a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. Petitioner did not submit a proper oath or declaration until the filing of the declaration accompanying the instant petition, on 05 April 1999. The declarations submitted on 10 March 1997 and 15 May 1997 do not constitute the required reply to the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) of 16 April 1997 because Uwe Witt did not attest to his country of citizenship in either declaration. Petitioner argues that the declarations, taken together, "give all the required data" and that therefore no further declaration is required under the practice of MPEP 602.02. Unfortunately, the declarations of 10 March 1997 and 15 May 1997 do not "give all the required data" in that inventor Uwe Witt did not execute all of the required data. As such, the two declarations, even taken together, are incomplete and so do not constitute the required reply. Therefore, the required reply was not submitted until the filing of the declaration accompanying the petition of 05 April 1999.

Petitioner argues that the portion of the delay in filing the required reply extending from the filing of the defective declaration of 15 May 1997 to the filing of a grantable petition was unavoidable because "Applicants could not be aware that their response was insufficient without being notified of any alleged insufficiency" and that "Because Applicants never received any notification that this time period was running, and because Applicants never received any indication that the case was abandoned, Applicants submit that the abandonment was unavoidable." However, petitioner was notified that the declaration of 10 March 1997 was defective by the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) mailed on 16 April 1997. Petitioner was notified that the declaration of 15 May 1997 was defective by the Notification of a Defective Response (Form PCT/DO/EO/916) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) of 25 June 1997. Therefore, petitioner was notified that both declarations were insufficient. Given such notice, petitioner was required to exercise appropriate diligence in submitting the required reply in a timely manner. Petitioner has not shown why, despite such notification, the delay in submitting a proper oath or declaration was unavoidable within the meaning of 37 CFR 1.137(a).

Petitioner argues that the Notification of Abandonment mailed on 02 January 1998 was not received, failed to properly identify the subject application and applicant, and was mailed to an incorrect address. Review of the record reveals that the Notification of Abandonment in fact did contain erroneous information, and was in fact not mailed to

applicants' correspondence address of record. Notwithstanding these facts, any improper mailing of the Notification of Abandonment does not operate to excuse petitioner from the requirement to exercise due diligence in responding to the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) mailed on 16 April 1997 and the Notification of a Defective Response (Form PCT/DO/EO/916) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) of 25 June 1997. As such, petitioner's arguments concerning the Notification of Abandonment are not sufficient to establish unavoidable delay within the meaning of 37 CFR 1.137(a).

DECISION

For the above reasons, Applicant's Request in the above-captioned application is **DISMISSED** without prejudice.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mailing date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any such request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." Applicant may also wish to consider filing a petition under 37 CFR 1.137(b).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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